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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/923,457	08/08/2001	Nobuya Okayama	500.40470X00	9085

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EXAMINER

OUELLETTE, JONATHAN P

ART UNIT PAPER NUMBER

3629

DATE MAILED: 04/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/923,457	Applicant(s) OKAYAMA ET AL.	
	Examiner Jonathan Ouellette	Art Unit 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>20041101</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Claims 1-37 have been amended. Claims 1-37 are currently pending in application 09/923,457.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. **Claim 35 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**
4. Independent Claim 5 described a step of increasing an amount of the digital contents if a predetermined set of parameters is exceeded.
5. However, it is unclear to the Examiner how the digital contents are increased and what parameters need to be exceeded. Increasing the digital contents could refer to the amount contents the user can access (size or number of files/content), increasing the availability of contents the user can access (larger database of files available), or the amount of time available for accessing the contents (increasing “limited time” period). The parameter could refer to the amount of content downloaded or the amount of time the user has been accessing the system.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. **Claims 34 and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by**

Archibald et al. (US 5,825,883).

8. As per **independent Claim 34**, Archibald discloses a method for calculating a licensing fee of digital contents comprising: counting the number of pages displaying digital contents (functionally, resource, number of access or invocations, and amount of database access); and calculating a fee in accordance with the number of displayed pages (C8 L38-56, Claims 1-4).
9. As per **independent Claim 35 as understood by the Examiner**, Archibald discloses a method for calculating a licensing fee of digital contents comprising: counting a display time (time increments) during which digital contents are displayed; and calculating a fee in accordance with the display time (C3-C4, C8 L38-56, Claims 1-4); and increasing an amount of the digital contents if a predetermined set of parameters is exceeded (allows user to access additional files (increase) after a file has already been accessed (parameter exceeded), Fig.3-5).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. **Claims 1-33, 36, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Archibald et al. (US 5,825,883).**

12. As per **independent Claims 1, 36, and 37**, Archibald discloses a method (system, computer readable recording medium storing a program) for calculating a licensing fee of digital contents comprising: a step of distributing digital contents from a center side distribution apparatus to a terminal apparatus (Fig.1, C3-C4); a step of allowing digital contents capable of being accessed (viewed and listened to) at a limited place (personal PC or mobile PC unit); a step of calculating an amount of digital contents viewed and listened to at the terminal apparatus (meter module); and a step of calculating a copyright fee in accordance with the calculated amount of digital content viewed and listened to (C3-C4, C8 L38-56, Claims 1-4).

13. Although, Archibald does disclose distributing the digital applications through several channels (C4 L35-40) and providing user access to several types of digital content and metering use with several different methods (C3-C4, C8 L38-56); Archibald fails to expressly disclose wherein the digital contents are distributed via a shop side distribution

apparatus; distributing digital contents within a limited time period; and a step of collecting an audiovisual fee according to the length of said limited time period.

14. Baranowski discloses wherein the digital contents are distributed via a shop side distribution apparatus (C2 L35-48, System controller to Transceiver base to Portable device); distributing digital contents within a limited time period (C13 L28-33, rental period, hours of retail operation); and a step of collecting an audiovisual fee (rental fee for equipment) according to the length of said limited time period (common rental fee pricing structure).
15. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included wherein the digital contents are distributed via a shop side distribution apparatus; distributing digital contents within a limited time period; and a step of collecting an audiovisual fee according to the length of said limited time period, as disclosed by Baranowski in the system disclosed by Archibald, for the advantage of providing a method of for calculating a licensing fee of digital contents, with the ability to increase system business effectiveness by providing rental equipment to users for accessing available services (C13 L19-33).
16. As per Claim 2, Archibald and Baranowski disclose making the terminal apparatus recognize the contents of a portable recording medium storing an audiovisual period of viewing and listening digital contents at the terminal apparatus (digital content can be released to users through network or recorded medium).

17. As per Claims 3 and 4, Archibald and Baranowski disclose recording personal operation history information and personal preference information managed in the terminal apparatus in a portable recording medium (Archibald: user ID, user data records).
18. As per Claims 5-8, Archibald and Baranowski disclose allowing a trial read of digital contents at the terminal apparatus capable of viewing and listening to the digital contents (Archibald: Fig.4, C9 L26-34, trial period).
19. As per Claims 9-16, Archibald and Baranowski fail to expressly disclose prolonging an audiovisual time of digital contents if an electronic advertisement is viewed and listening to at the terminal apparatus capable of viewing and listening to the digital contents.
20. However, Archibald does disclose offering discounts and incentives to users (C9 L13-25), and Official Notice is taken that compensating users for viewing advertisements was well known to one of ordinary skill at the time the invention was made, as a form of marketing and user incentive; and it would have been obvious to compensate the user with incentives related to receiving digital content.
21. As per Claims 17-32, Archibald and Baranowski fail to expressly disclose printing a portion or all of digital contents, a step of checking whether the digital contents can be printed, a step of calculating a copyright fee of the printed digital contents, and a step of displaying the calculated result on a display.
22. However, Archibald does disclose monitoring user actions with digital contents and calculating a fee based on the use of the digital content (C3-C4), and printing information based on digital content was well known to one of ordinary skill in the art at the time the invention was made.

23. Therefore, it would have been obvious to include a printing step to be monitored by the metering system described by Archibald.
24. As per **independent Claim 33**, Archibald discloses a method for calculating a licensing fee of digital contents comprising: calculating an amount of the digital contents viewed and listened to; and calculating a copyright fee in accordance with the calculated amount of the digital contents (C3-C4, C8 L38-56, Claims 1-4).
25. Although, Archibald does disclose providing user access to several types of digital content and metering use with several different methods (C3-C4, C8 L38-56), Archibald fails to expressly disclose outputting the digital contents during a limited time period; collecting an audiovisual fee according to the length of said limited time period.
26. Baranowski discloses distributing digital contents within a limited time period (C13 L28-33, rental period, hours of retail operation); and a step of collecting an audiovisual fee (rental fee for equipment) according to the length of said limited time period (common rental fee pricing structure).
27. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included outputting the digital contents during a limited time period; collecting an audiovisual fee according to the length of said limited time period, as disclosed by Baranowski in the system disclosed by Archibald, for the advantage of providing a method of for calculating a licensing fee of digital contents, with the ability to increase system business effectiveness by providing rental equipment to users for accessing available services (C13 L19-33).

Response to Arguments

28. Applicant's arguments with respect to claims 1-33, and 35-37 have been considered but are moot in view of the new ground(s) of rejection. This is a **NON-FINAL** rejection.

29. Applicant's arguments with respect to claim 34 have been considered but are not persuasive.

30. The Applicant has made the argument that the cited prior art fails to teach or suggest calculating a fee based on the number of pages displaying digital contents.

31. However, Archibald does disclose monitoring/charging for user consumption, based on several different criterion, such as time, time increments, functionally, resource, number of access or invocations, and amount of database access (C8 L38-56). This list of criterion clearly covers the number of pages displaying digital contents, as functionally, resource, number of access or invocations, and amount of database access, could all be considered equivalents to measurements of pages displaying digital contents.

Conclusion

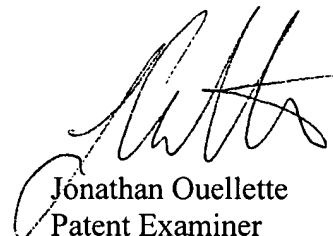
32. Additional Literature has been referenced on the attached PTO-892 form, and the Examiner suggests the applicant review these documents before submitting any amendments.

33. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Ouellette whose telephone number is (571) 272-6807. The examiner can normally be reached on Monday through Thursday, 8am - 5:00pm.

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34. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone numbers for the organization where this application or proceeding is assigned (571) 273-8300 for all official communications.
35. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Office of Initial Patent Examination whose telephone number is (703) 308-1202.

April 3, 2006



Jonathan Ouellette
Patent Examiner
Technology Center 3600